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**OFFICE OF PETITIONS**

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| In re Patent No. 7,425,547 | : |                        |
| Roberts et al.             | : | DECISION               |
| Application No. 10/676,956 | : | DISMISSING REQUEST FOR |
| Issued: September 16, 2008 | : | RECONSIDERATION OF     |
| Filed: September 30, 2003  | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No.        | : | UNDER 37 CFR 1.705(d)  |
| 355491-1250(G081US)        | : |                        |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705," filed on October 28, 2008, requesting that the patent term adjustment determination for the above-identified patent be changed from two hundred sixty-seven (267) days to seven hundred eight-two (782) days.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of 267 days.

**BACKGROUND**

On August 27, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 267 days.

On September 16, 2008, the application matured into U.S. patent No. 7,425,457, with a patent term adjustment of two hundred sixty-seven (267) days.<sup>1</sup>

<sup>1</sup> No application for Patent Term Adjustment was timely filed disputing the initial determination.

On October 28, 2008, this request for reconsideration of the patent term adjustment was timely filed.

37 CFR 1.703(f) provides that:

The adjustment will run from the expiration date of the patent as set forth in 35 U.S.C. 154(a)(2). To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. The term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704. The date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation.

#### OPINION

On September 16, 2008, this patent issued with a patent term adjustment determination of two hundred sixty-seven (267) days. Patentees argue that the determination of 267 days is in error in that pursuant to 35 U.S.C. § 154(b) the Office failed to issue a patent within three years of the actual filing date of the above-referenced application in accordance with 37 CFR § 1.702(b) and failed to take certain action within the time frames specified in 37 CFR § 1.702(a).

Specifically, patentees argue that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), is 717 days. This 717 day period is calculated based on the application having been filed under 35 U.S.C. 111(a) on September 30, 2003, and the patent having not issued until September 16, 2008, three years and 717 days later. Patentees maintain that in addition to this 717 day period, they are entitled to a period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), totalling 627 days. Patentees have calculated this delay as follows: a period of delay of 518 days for the failure by the Office to mail at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application was filed under

35 U.S.C. 111(a), pursuant to § 1.702(a)(1); and a period of 109 days for the failure by the Office to respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken, pursuant to § 1.702(a)(2).

On April 11, 2008, the issue fee was paid. On September 16, 2008, four (4) months and thirty-six (36) after payment of the issue fee, the application issued as U.S. Patent No. 7,425,547. Pursuant to 37 CFR 1.704(a)(4), an additional period of adjustment of 36 days was entered. Accordingly, the total period of Examination delay under 37 CFR 1.702(a) is 663 days.

The period of reduction of 450 days for applicant delay is not in dispute.<sup>2</sup> Patentees maintain that the total period of Office delay is the sum of the period of Three Years Delay (717 days) and the period of Examination Delay (663 days)<sup>3</sup> **to the extent that these periods of delay are not overlapping.**

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<sup>2</sup> The period of reduction is calculated as follows: a 21 day period of reduction for the filing of a response to the Office action mailed on May 2, 2006, on August 23, 2006, which is three (3) months and 21 days after the mailing of the Office action pursuant to 37 CFR 1.704(b); a 217 day period of reduction for the filing of an IDS on March 28, 2007, 217 days after the filing of a response to a non-final Office action on August 23, 2006, pursuant to 37 CFR 1.704(c)(8); a 92 day period of reduction for the filing of a response on October 11, 2007, to a non-final Office action mailed on April 11, 2007, three (3) months and 92 days after the mailing of the non-final Office action, pursuant to 37 CFR 1.704(b); a reduction of 123 days for the filing of an amendment filed after the mailing of the notice of allowance filed on April 11, 2008, and the date a response to the amendment after the mailing of the notice of allowance was mailed, or four (4) months.

With regard to applicant's assertion that a 123 day period of reduction should be entered, it is noted that 37 CFR 1.704(c)(10) states that circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping: Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of: (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or (ii) Four months. As the response to the amendment after the mailing of the notice of allowance was mailed 123 days, or more than four (4) months after the filing of the amendment after the mailing of the notice of allowance, the period of reduction under 37 CFR 1.704(c)(10) is set at 120 days. Accordingly, for purposes of consistency in the analysis on this petition, the period of delay will be referred as a 120 day period of reduction.

<sup>3</sup> For purposes of consistency in the analysis of this petition, the period of examination delay under 37 CFR 1.702(a) will be referred to as 663 days, as computed by the Office, rather than the 627 days claimed by patentees.

Patentees contend that:

As the period of 14 month delay ended on November 30, 2004, prior to the first day of the period of Three Years Delay, i.e., September 30, 2006, Patentees submit that these periods are not overlapping.

As such, patentees assert, in essence, entitlement to a patent term adjustment of 930 (663+717-450) days.

The Office agrees that the patent issued 3 years and 717 days after its filing date. The Office agrees that the actions detailed above were not taken within the specified timeframes, and thus, the entries of a period of adjustment of 267 days respectively are correct. At issue is whether patentees should accrue 930 days (717 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as, 663 days for Office failure to take certain actions within specified time frames (or examination delay), or that period not considered to overlap, less 450 days of applicant delay).

The Office does not agree and contends that the entire period of 663 days overlap. Patentees' interpretation of the period of overlap has been considered and found to be incorrect. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

The current wording of § 1.703(f) was revised in response to the misinterpretation of this provision by a number of applicants. The rule was slightly revised to more closely track the corresponding language of 35 U.S.C. 154(b)(2)(A). The relevant portion differs only to the extent that the statute refers back to provisions of the statute whereas the rule refers back to sections of the rule. This was not a substantive change to the rule nor did it reflect a change of the Office's interpretation of 35 U.S.C. 154(b)(2)(A). As stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has

consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed. The grounds specified in these sections cover the A) guarantee of prompt Patent and Trademark Office responses, B) guarantee of no more than 3 year application pendency, and C) guarantee or adjustments for delays due to interference, secrecy orders and appeals. A section by section analysis of 35 U.S.C. 154(b)(2)(A) specifically provides that:

Section 4402 imposes limitations on restoration of term. In general, pursuant to [35 U.S.C.] 154(b)(2)(A)-(C), total adjustments granted for restorations under [35 U.S.C. 154](b)(1) are reduced as follows: (1) To the extent that there are multiple grounds for extending the term of a patent that may exist simultaneously (e.g., delay due to a secrecy order under [35 U.S.C.] 181 and administrative delay under [35 U.S.C.] 154(b)(1)(A)), the term should not be extended for each ground of delay but only for the actual number of days that the issuance of a patent was delayed; See 145 Cong. Rec. S14,718<sup>4</sup>

As such, the period for over 3 year pendency does not as argued by patentees overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within

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<sup>4</sup> The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106<sup>th</sup> Cong. 1<sup>st</sup> Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999) (daily ed. Nov. 17, 1999).

specified time frames. In other words, consideration of the overlap does not begin three years after the filing date of the application. Patentees are incorrect in treating the relevant period as starting on September 30, 2006, the date that is 3 years after the actual filing date of the application.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, September 30, 2003 to September 16, 2008. (There were no periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). 663 days (518+109+36) days of patent term adjustment were accorded prior to the issuance of the patent for the Office failing to respond within specified time frames during the pendency of the application. All of these 663 days overlap with the 717 days for Office delay in issuing the patent. Accordingly, at issuance, the Office properly entered 54 days (717 - 663 days) additional days of patent term adjustment for the Office taking in excess of 3 years to issue the patent.

In view thereof, the Office affirms that the correct revised determination of patent term adjustment at the time of the issuance of the patent is 267 days.

#### CONCLUSION

The request for reconsideration of the revised patent term adjustment is dismissed.

The Office acknowledges patentees submission of the \$200.00 fee set forth in \$1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Douglas I. Wood, Senior Petitions Attorney, at (571) 272-3231.



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